REMARKS

This amendment and remarks is filed along with a Notice of Appeal in response to the Office Action dated July 27, 2006 (hereinafter "Office Action"). Applicant requests that the suggested amendments be entered in order to place the application in better condition for appeal or in condition for allowance. In addition, Applicant asks that the Examiner consider the amendments and remarks and contact the Applicant prior to the deadline for filing an Appeal Brief.

Claims 1-22 are pending in the present application. By this amendment, claims 1, 10, 13, 21 and 22 have been amended. No new matter has been added.

Support for Claim Amendments

Amended claims 1, 13, 21 and 22, expressly recite identifying from the pool of test takers, those test takers that possess sub-par numerical credentials for admission to said first academic institution. The first academic institution is the academic institution conducting the search and to which test takers who successful complete the abbreviated academic program are ultimately admitted. One aspect of support is found in the stated purpose of the invention: a method to assist "admissions officers with identifying those admissions candidates *possessing sub-par numerical credentials* who would otherwise succeed as a student in an academic institution," see p. 5, ln. 2-5. Clearly, in the context of the overall disclosure, this purpose teaches that the searching institution would look for students, whether they initially applied to the first institution or not, who possess sub-par numerical credentials for admission to the searching institution but would otherwise succeed as students.

The shifting range disclosed in the specification provides additional support for the amendment, *see* Specification, p. 13, ln. 6-9. Three shifting ranges are taught for identifying admission candidates that may be eligible for the abbreviated academic program. An admission candidate having a score in the shifting range taught by the present invention would have a 50% or better likelihood of admission to, at best, between 4 and 8 of the 181 ABA-approved law school participating in the Searchable Edition of the Official Guide to ABA-Approved Law School, *available at* http://officialguide.lsac.org/docs/cgi-bin/home.asp, click on LSAC Data Search. *See also* Specification, p. 13, ln. 6-9. This comparison is set forth in more detail in the

discussion of secondary considerations set forth below. Thus, the specification teaches a search using a shifting range that identifies admissions candidates who possess sub-par numerical credentials for admission to a "first academic institution," or just about any ABA-approved law school. This provides additional support for the amendment drawn to searching for test takers who possess sub-par numerical credentials for admission to the first academic institution.

The amendment finds additional support throughout the specification, for example Figure 1 and p. 11, ln. 13 – p. 12, ln. 18. The specification teaches that the invention "contemplates a student who has been rejected from multiple academic institutions and subsequently, by virtue of the method of the invention, permanently enrolls in an academic institution for which the student had not initially applied for admission," p. 12, ln. 15-19. Because the purpose of the invention is to identify admissions candidates possessing sub-par numerical credentials who would otherwise succeed as a student in the academic institution, see p. 5, ln. 2-5, the student is presumably rejected because he or she "has associated therewith an insufficient GPA and standardized test score," p. 11, ln. 18-20. Other areas providing support for this amendment include p. 5, ln. 2-5 and p. 7, ln 12-23. Clearly, the amended language has support in the specification and no new matter is introduced by the current amendments.

Claim Rejections Under 35 U.S.C. §112, paragraph 1

The Office Action rejected claims 1-12 under 35 U.S.C. §112, first paragraph, as failing to comply with enablement requirement. The Examiner is unable to identify how the Applicant intends to find out which students have applied to other schools and have not received offers. If the amendment is entered this rejection is moot since all references to academic institutions other than the first academic institution that would ultimately admit the student have been removed from all pending claims. Accordingly, Applicants request the foregoing amendments be entered in order to place the application in condition for allowance.

Claim Rejections Under 35 U.S.C. §102(b)

Claims 1, 13 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by www.gradcollege.swt.edu (hereafter "Grad College"). The Applicant respectfully submits that Grad College does not teach the method of the claimed invention.

Before addressing Grad College, Applicant will review the claimed inventive method for school admission as set forth in Amended Claim 1. An admissions body selects pool of standardized test takers that includes some test takers that did not initially apply for admission to a first academic institution. The admissions body uses a computer product to identify those who possess sub-par numerical credentials for admission to the first academic institution. The admissions body then provides a program for admission to the first academic institution, wherein the program for admission includes an abbreviated academic program that does not count for credit toward graduation from the first academic institution. The test takers that participate in the abbreviated academic program are subjected to at least one scored examination during the abbreviated academic program. Finally, those test takers that achieve a score on the at least one examination that satisfies an admissions criteria are admitted to the first academic institution

Grad College is directed to the well known practice of conditionally admitting students who have already applied to a university. Traditionally, a student who applies to an academic institution but possesses borderline qualifications may be offered conditional admission. Students who are conditionally admitted to an academic institution take classes with regularly admitted students and, assuming they pass the class, the conditionally admitted student receives credit.

Grad College does not anticipate the claimed invention because it fails to disclose several elements of the claimed invention. First, Grad College does not disclose an academic institution conducting a search for test takers that do not have acceptable qualifications for admission to that academic institution. Second, Grad College does not disclose a program for admission that includes an abbreviated academic program that is not taken for credit.

The first distinction is that the claimed invention is drawn to an academic institution conducting a search for test takers who possess qualifications that are *not acceptable* for admission to the academic institution. The Examiner never asserts that any of the cited art expressly discloses this element. However, the Examiner discusses this element in paragraph 30 of the Office Action. The Examiner states, it is "inherent when doing a search for *admissible students* to an institution" to search for those who have not already applied to the institution. The Applicant agrees that the Examiner's statement summarizes what is know and expected by one of ordinary skill in the art. However, the Examiner's statement does not address the claimed

invention, which is drawn to conducting a search for test takers who *possess sub-par numerical credentials for admission to the institution conducting the search.* This element is neither inherent nor obvious in light of the cited art or knowledge of one having ordinary skill in the art. The Examiner's statement serves to emphasize this lack of disclosure or obviousness. Accordingly, Applicant submits that claims 1, 13, 21, 22, and all claims dependent thereon currently present allowable subject matter.

The second distinction is that the abbreviated academic institution is not taken for credit. While arguing the second distinction, the Examiner cites two portions of Grad College, see Office Action, paragraph 5. The first aspect cited by the Examiner is labeled "Continuing Education Study," see Grad College, p. 14, paragraph E. The description states, "Continuing education courses are non-credit hour classes and are not offered through the Grad College. They do **not** apply toward a graduate degree program at SWT and are not considered for regular admission," see id. This is contrary to the claimed invention, where performance in the abbreviated academic program offered for no credit is the primary measure used to determine admission to the graduate school. Accordingly, the continuing education study section of Grad College does not disclose or suggest this element of the claimed invention.

The second aspect of Grad College asserted to disclose the element of an abbreviated academic program that is not take for credit is under the section labeled "Transfer of Credit," see Grad College, p. 17, paragraph C. The section deals with whether a student accepted to the Southwest Texas State University (STSU) can get STSU credit for based on *credits the student already earned at another institution.* Thus, in the Grad College passage cited by the Examiner, not only was the class taken for credit, but another academic institution already granted the student credit for the class. Clearly, this transfer of credit section does not disclose the claimed element of a program for admission that includes an abbreviated academic program not taken for credit. For at least the reasons established above, Applicant submits that claims 1, 13 and 20, and all claims dependent thereon currently present allowable subject matter.

Claim Rejections Under 35 U.S.C. §103 (a)

Claims 2-12, 14-29, 21 & 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over www.gradcollege.swt.edu (hereafter "Grad College") in further view of

multiple different references. The Applicant respectfully submits that no combination of Grad College with the cited reference discloses or suggests the method of the claimed invention.

A prima facie case of obviousness requires (1) a motivation or suggestion to combine the teachings of the references, (2) a reasonable expectation of success, and (3) that the prior art references *must teach or suggest all the claim limitations*. *See* MPEP §2143. An obviousness rejection cannot be sustained if any of these elements is not established or the applicant can rebut any of the elements. As discussed above, Grad College does not disclose an academic institution conducting a search for test takers that possess sub-par numerical credentials for admission to that academic institution. In addition, Grad College does not disclose or suggest a program for admission that includes an abbreviated academic program that is not taken for credit. In fact, none of the cited art teaches or suggests these elements of the present claims.

Accordingly, Applicant asserts that claims 2-12 & 14-19, which depend on claims 1 & 13, present patentable subject matter as set forth above and because of features recited therein. The Applicant further asserts that since claims 21 & 22 contain the elements set forth above and additional features, these claims also present patentable subject matter.

In addition, Applicant requests the Examiner consider secondary considerations, such as the failure of others and long-felt but unresolved needs, as indicia of nonobviousness, *see* MPEP §716.01(a). Philip D. Shelton, President of the LSAC, the group that administers the LSAT, states that the LSAT is the best standardized admission test in the admission testing industry. *See* Affidavit of Philip D. Shelton. The score a test taker achieves on the LSAT, while representing a bell curve centered on that value, is indicative of the most likely level of performance in law school. Thus, like all bell curves, a significant percentage of test takers with a given score will perform better than the mode, i.e. the performance level of the test taker with a given score having the average performance level in law school.

Mr. Shelton states that *even after extensive research*, the LSAC has been unable to identify a single variable or combination of variables that will identify test takers who will significantly outperform test takers with much higher scores. *See* Affidavit of Philip D. Shelton, paragraph 4. Mr. Shelton goes on to state:

> The claimed methods [of the present invention] are more effective at identifying students with a lower LSAT score who perform at the high end of the bell

> curve more effectively than any other admissions method of which I am aware. In short, the AAMPLE® program incorporating the claimed methods presents a method that has proven successful for identifying "diamonds in the rough" who will perform well at law school despite a relatively low LSAT score.

See Affidavit of Philip D. Shelton, paragraph 6.

As noted above, the LSAT is the best standardized admissions test in the industry. Thus, if the LSAT cannot identify high-performing, low-scoring test takers, neither can the MCAT, DAT, VCAT, PCAT, AHPAT, GRE, or the GMAT. In fact, the need for the method of the present claims would be even greater for these other admissions tests.

In response to the above secondary considerations, the Examiner asserts that Applicant has not shown that the claimed invention has successfully identified students who will perform better than higher test scorers in an actual law program, see Office Action, paragraph 30. The Applicant respectfully disagrees.

Applicant provides Table 1 as a starting point for providing an idea of how the shifting range taught in the specification relates to real world opportunities for admission to law schools as demonstrated by the Searchable Edition of the Official Guide to ABA-Approved Law School, *available at* http://officialguide.lsac.org/docs/cgi-bin/home.asp, click on LSAC Data Search. Table 1 shows the shifting ranges disclosed in the specification, see. p. 13, ln. 6-9, and several measures of likelihood of admission to law schools for students with LSAT scores and GPAs in each range. The column labeled Albany Law, NY Law and NSU Law (Law Center of Nova Southeastern University), indicates the estimated likelihood of an admission candidate with the best possible combination of LSAT and GPA in each shifting range, for example 135 LSAT & 4.00 GPA, 140 LSAT & 4.00 GPA and 145 LSAT & 2.99 GPA. The column labeled >50% likelihood at LSAC participating law schools indicates the number of participating law schools where the Official Guide estimates the likelihood of admission at 50% of greater. Printouts of the results from each search are filed along with this response.

Table 1. Relative likelihood of admission for test takers with scores in the shifting range taught by Applicant's specification.

LSAT Average	Self-Reported GPA	Likelihood of Admission	
		Albany Law, NY Law and NSU Law*	>50% likelihood at LSAC Participating Law Schools**
130-135	3.00-4.00	Albany - <10% NY Law - <10% NSU Law - <10%	4 of 181 Schools
136-140	3.00-4.00	Albany - <10% NY Law - <10% NSU Law - <15%	8 of 181 Schools
141-145	2.5-2.99	Albany - <10% NY Law - <10% NSU Law - <20%	4 of 181 Schools

* < 10% is the lowest reading that the Searchable Edition reports.

** There are ten nonparticipating law schools: UC-Berkeley, UC-Davis, UC-Hastings, Catholic University of America, University of Chicago, Columbia University, Cornell Law, Franklin Pierce Law Center, University of Nevada Las Vegas, and Stanford University.

Based on the results set forth in Table 1, any student who gains admission using the AAMPLE® program ("AAMPLE® Qualifier"), which uses the disclosed shifting ranges, to gain admission to NSU Law, Albany, or NY Law, and does not finish last in their class is probably performing better than higher test scorers in an actual law program. In addition, there can be no question that an AAMPLE® Qualifier who finishes with a GPA above the median GPA is performing better than some higher test scorers in an actual law program.

In response to the First Office Action mailed August 19, 2004, Applicant submitted an affidavit from Applicant Joseph Harbaugh, the Dean of the Law Center of Nova Southeastern University. In his affidavit, Dean Harbaugh states that the median GPA of all NSU Law students after their first year is between 2.5 and 2.6, *see* Affidavit of Joseph Harbaugh, paragraph 9. Dean

Harbaugh also submitted a chart showing that 43%, or 37 out of 85, of the AAMPLE® Qualifiers at NSU Law had a GPA of 2.5 or more after their first year at NSU Law, *see* Affidavit of Joseph Harbaugh, paragraph 8. These students had an LSAT score below 145, but performed better than at least about 50% of the NSU Law students. For purposes of comparison, the NSU Law class entering in 2005 had a median LSAT of 150, a 25th percentile of 148 and a 75th percentile of 152, *see* LSAC Official Guide, *available at* http://officialguide.lsac.org/OFFGUIDE/pdf/aba5514.pdf. This is but one example where the claimed method, as employed by the AAMPLE® program, has identified students who will perform better than higher test scorers in an actual law program.

In addition, Applicant points to the Affidavit of Thomas F. Guernsey filed along with the response to the first office action mailed August 19, 2004. Mr. Guernsey is the Dean of Albany Law School. Dean Guernsey states that seven students were admitted to Albany Law School and six successfully completed their first semester of studies with GPAs between 2.29 and 2.83. Based on these GPAs, some of these AAMPLE® Qualifiers would have outperformed higher test scorers in an actual law program.

Applicant has established the claimed process can successfully identify students who will perform better than higher test scorers in the actual law program. Accordingly, Applicant has successfully rebutted the Examiner's assertions that Applicant has not shown that the claimed invention has successfully identified students who will perform better than higher test scorers in an actual law program.

In the Office Action, the Examiner asserts that there is no showing that others of ordinary skill in the art were working on the problem. Again, Applicant respectfully disagrees. As set forth above, Philip Shelton's affidavit states that the LSAT is the best standardized test in the industry because it correlates with law school performance more highly than any other test correlates to performance in the academic disciplines the test is designed to forecast, *see* paragraph 3. Mr. Shelton also states that the LSAT is has "conducted extensive research over many years" in order to obtain a test that can better identify "diamonds in the rough," *see* paragraph 4. However, Mr. Shelton concedes that the claimed methods are more effective at identifying these "diamonds in the rough" than any other admissions method of which he is aware, *see* paragraph 6. It seems beyond argument that the test designers of the LSAT, the best standardized test in the industry, are of at least ordinary skill in the art. Mr. Shelton states that

these highly qualified individuals have been conducting research on this problem for many years without identifying a method better than the claimed invention. Accordingly, it seems clear that Applicant has rebutted the Examiner's assertion that Applicant has not shown that others of ordinary skill in the art were working on the problem has been successfully rebutted.

For at least the reasons given above, Applicants respectfully submit that all claims in the present Application present patentable subject matter. Accordingly, the Applicant respectfully submits that all pending claims are in condition for allowance.

Conclusion

For at least the reasons given above, Applicant submits that claims 1-22 define patentable subject matter and are in condition for allowance. Accordingly, Applicant respectfully requests allowance of these claims prior to the need for filing an RCE or Notice of Appeal. The foregoing is submitted as a full and complete Response to the Office Action mailed July 27, 2006, and early and favorable consideration of the claims is requested. Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicant's representative at the telephone number listed below. No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 50-0951.

Respectfully submitted,

Date: 10/24/06

J. Rodman Steele, Jr.
Registration No. 25,931
Gregory M. Lefkowitz
Registration No. 56,216
AKERMAN SENTERFITT
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000